



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,328	12/23/2005	Tapas Kumar Kundu	88870.001	1552

7590	04/24/2007
Intellectual Property Department	
Bewitt Ross & Stevens	
8000 Excelsior Drive	
Suite 401	
Madison, WI 53717-1914	

EXAMINER	
KUMAR, SHAILENDRA	

ART.UNIT	PAPER NUMBER
1621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/538,328	KUNDU ET AL.	
	Examiner	Art Unit	
	SHAILENDRA -. KUMAR	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 5-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicants' communication filed on 2/5/07.

Claims 5-16 are pending in this application.

1. Applicant's election with traverse of Group I, claims 5-14 in the reply filed on 2/5/07 is acknowledged. The traversal is on the ground(s) that the office has not carried the burden of providing any reasons and /or examples to support that the claims are distinct Applicants further allege that since in PCT, there is no lack of unity, hence there should not be any restriction requirement in herein. This is not found persuasive because at the outset, the examiner has fully explained the reason for the restriction requirement in the office action of 10/14/06. With respect to PCT application, US practices different criteria for restriction requirement than the unity of invention for PCT.

The requirement is still deemed proper and is therefore made FINAL.

Rejection of claims 5-6, 10 and 14 under 35 USC 102(b) over US'067 is hereby withdrawn subsequent to applicants' amendments.

Claim Rejections - 35 USC § 112

2. Claims 11-13 are again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons as set forth in the office action of 10/14/06.

Applicants' arguments were fully considered and were not found convincing.

Applicants have given example of coumadine, a blood thinner as an example as to why

Art Unit: 1621

their compounds can treat cancer and AIDS. The examiner does not understand the probative value of the comparison. Coumadine is well known blood thinner and has undergone extensive clinical trials. While, the examiner does not dispute that applicants do not have to make and test all of the species, but there should be some relationship shown with respect to the in-vitro data to the various forms of cancer or AIDS treatment. Cancer in itself can be of many types with various morphology, and it is unbelievable on its face that compounds as simple as claimed herein can treat all the types of cancer, absent evidence to the contrary. Applicants need to show correlationship of HAT activity with various treatments as claimed herein. Applicant's citation of various articles suggesting that HAT activity is related with HIV and cancer is good for the research purposes, and that does not mean that applicants' compounds can be used for treatment of these diseases.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 8, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Lenz(J. Org. Chem., 1974)

Lenz, page 2842, Table II, compounds 17-19 anticipate instant claimed compounds.

Claim Rejections - 35 USC § 103

7. Claims 5-8 and 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenz in view of US'067.

Lenz teaches structurally similar compounds as claimed in herein. See for example, compounds in Table II on page 2842. The difference between the reference and herein claimed compounds is that the reference does not teach R1 to be alkyl.

US'067 is teaching structurally similar compounds wherein it is expressly taught the equivalence of hydrogen and alkyl, see column 1, lines 20-25.

8. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify Lenz, by substituting hydrogen for methyl, because the latter reference is expressly teaching the equivalence of hydrogen and methyl. Note preparation of compounds on page 2844, column 2, paragraph 1, which is analogous to the claimed process.

9. Claim 9 appears to be free of prior art and is allowable.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1621

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

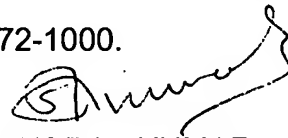
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571)272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SHAIENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
4/17/07